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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,937	10/24/2003	Roger D. McCumber	2968.256US01	2118
23552	7590	04/09/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/692,937

Applicant(s)

MCCUMBER, ROGER D.

Examiner

EDWYN LABAZE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1222004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Receipt is acknowledged of IDS filed on 1/22/2004.
2. Claims 1-30 are presented for examination.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-24 and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Cyr et al. (U.S. 6,138,913).

Re claims 1, 10, and 18: Cyr et al. discloses security document and method using invisible coded markings, which includes a card 10 (as shown in fig. # 1 of Cyr et al.) comprising of a first and second opposite major surfaces [through reference 12 as disclosed in fig. # 1 of cry et al.] and a perimeter edge surface (col.4, lines 55+), and at least one communication marking 16 provided on at least a portion of the perimeter edge surface (col.5, lines 5+); and wherein the communication marking being formed from a non-visible ink (col.4, lines 43+; col.6, lines 19+).

Re claims 2, 11, and 19: Cyr et al. teaches an apparatus, wherein the perimeter edged surface comprises a top edge surface, and the communication marking 16 is provided on at least a portion of the top edge surface (col.5, lines 5+).

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Re claims 3 and 13: Cyr et al. discloses an apparatus and method, further comprises a plurality of the communication markings [such as name, city, state, zip code or the like] (col.5, lines 1+).

Re claims 4, 14, and 20: Cyr et al. teaches an apparatus and method, wherein the communication markings 16 comprise a bar code (col.5, lines 18-37).

Re claims 5 and 15: Cyr et al. discloses an apparatus and method, wherein the communication marking comprises a number, a letter, or a symbol [such as a bar code 16 printed on the top surface 12 of the card 10] (col.5, lines 18+).

Re claims 6, 16, and 22: Cyr et al. teaches an apparatus and method, wherein the communication marking is formed from non-visible ink (col.4, lines 43+; col.6, lines 19+).

Re claim 7: Cyr et al. discloses an apparatus and method, wherein the non-visible ink comprises UV or IR ink (col.5, lines 5-12; col.6, lines 19-42).

Re claims 8 and 12: Cyr et al. teaches an apparatus and method, wherein the communication marking [Cyr et al. teaches that some printed information on (either the top/first or bottom/second major surfaces) the card; such as name, city, state, zip code; are visible to light] is visible to the naked eye or visible light (col.6, lines 53+; col.9, lines 16-19).

Re claims 9 and 17: Cyr et al. discloses an apparatus and method, wherein at least one of the first or second major surfaces contains cardholder information [such as name, city, state, zip code or the like; as shown in fig. # 1 of Cyr et al.] (Col.5, lines 1+).

Re claim 21: Cyr et al. teaches an apparatus and method, wherein forming the communication marking 16 comprises printing the printing on the perimeter edge surface (as shown in fig. # 1 of Cyr et al; col.5, lines 17+).

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Re claim 23: Cyr et al. discloses an apparatus and method, wherein the step of providing comprises providing a plastic card (col.5, lines 45-55).

Re claim 24: Cyr et al. teaches apparatus and method, comprising of means of forming at least one communication marking [such as the bar code 16 as shown in fig. # 1 of Cry et al.] on at least a portion of a perimeter edge surface [such as lower right hand corner of the card] of the identity/card 10 document (col.5, lines 12+); reading [using a scanner with decoder so as to read the bar code 16 printed on lower right hand corner of the card, as disclosed in example 1] the communication marking (col.8, lines 8+); and based on the reading [through the scanner disclosed in example 1 to decode the encoded information, which can provide a considerable amount of detailed data regarding the recipient such as zip code, street address, name and other information as may be necessary to properly sort and process the envelope/card 10], determined whether the identity document is the proper document (col.5, lines 18-30).

Re claim 26: Cyr et al. discloses apparatus and method, wherein the identity document comprises a plastic card (col.5, lines 45-55), and comprising reading the communication marking within a card processing module [which could be through a scanning system by the scanning the embedded bar code on the card, a magnetic reader with a sliding slot, or contact-less reading means] of modular card processing system (col.8, lines 8+).

Re claim 27: Cyr et al. teaches apparatus and method, comprising reading the communication marking as part of a determination as whether the card is to be affixed to, or has been properly affixed to, a mailer from (col.5, lines 18-30).

5. Claims 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Baldwin et al. (U.S. 5,444,230).

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Re claim 28: Baldwin discloses solid-state optical reader with bi-directional protocol, which includes a housing 12 (col.3, lines 50+); a slot 14 formed in the housing defining a card path along which at least a portion of the card, including the perimeter edge surface containing the communication marking, can travel (col.3, lines 52+); a reading area defined in the slot 14 at which the communication marking [herein defined as a barcode or marks 36 on the card 16] can be read [by the optical sensor 24] (as shown in fig. # 3 of Baldwin; col.4, lines 16+); a light source 22a-22i providing light to the reading area 24 (col.4, lines 8+); and a light receiver [through the sensor 24] sensing light that has been reflected from the perimeter edge surface (as shown in fig. # 9 of Baldwin; col.11, lines 1-30).

Re claim 29: Baldwin teaches an apparatus, wherein the light source 22a is an ultraviolet light source providing ultraviolet light (col.5, lines 1-32).

Re claim 30: Baldwin discloses an apparatus, wherein the light receiver is an ultraviolet light sensor 24 (col.5, lines 1-32).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cyr et al. (U.S. 6,138,913) in view of May (U.S. 6,491,216).

The teachings of Cyr et al have been discussed above.

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Cyr et al. fails to teach means of reading the communication marking with an input hopper/receptacle of card processing equipment.

May discloses security system, which includes a means of reading the communication marking with an input hopper/receptacle/slot 14 of card 16 processing equipment 12 (as shown in fig. # 1 of May; col.3, lines 20+).

In view of May's teachings, it would have been obvious to an artisan of ordinary skill in the art the time the invention was made to employ into the teachings of Cyr et al. means of reading the communication marking with an input hopper/receptacle/slot of card processing equipment as an alternative means of reading the encoded information of the bar code. Although Cyr et al.'s teachings [and even the claimed invention] are not about a (specific) reader for reading the envelope/card 10, it is well known in the art of many readers [such as with an input hopper/slot so as to read the communication markings and furthermore modifying Cyr et al.'s teachings so as include a reader with an input hopper would be only a matter of choice for reading the bar code. Moreover, such modification would have been obvious extension as taught by Cyr et al., therefore an obvious extension.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Soules et (U.S. 5,259,907) discloses method of marking coded playing cards having machine-readable coding.

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Yoshihara (U.S. 5,270,526) teaches card type recording medium and method of preventing a false use thereof.

Nishida et al. (U.S. 5,366,252) discloses infrared-absorbing mark printed matter.

Auslander et al. (U.S. 5,693,693) teaches bar code printing and scanning using wax based invisible fluorescent inks.

Tahara et al. (U.S. 5,856,048) discloses information-recorded media and methods for reading the information.

Urano et al. (U.S. 6,168,1081) teaches method and apparatus for reading invisible symbol.

Shinji et al. (JP 405054210) discloses identification card and entrance control system using the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395.

The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el

Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
March 20, 2004

A handwritten signature in black ink, appearing to read 'Thien M. Le', with a long horizontal stroke extending to the right.

**THIEN M. LE  
PRIMARY EXAMINER**